

Appl. No.: 09/497,383
Arndt. dated 07/21/2005
Reply to Office action of April 21, 2005

REMARKS

1. Status of Claims

In the Office action, the Examiner noted that Claims 1-16, 18-27, 29-33, 35-53 and 55-75 were pending in the application, and all claims were rejected.

By the present Amendment, Claims 1-16, 18-27, 29-33, 35-53 and 55-75 remain pending in the application.

The rejections are addressed in succession below.

2. Rejection of Claims 1, 3-16, 18-22, 24-27, 29-33, 35-53, 55-62, and 64-75 under 35 U.S.C. 102(a)

On pages 2-19 of the Office action, Claims 1, 3-16, 18-22, 24-27, 29-33, 35-53, 55-62, and 64-75 were rejected under 35 U.S.C. §102(a) based on a Data Sheet printed March 28, 2000.

2.1. Quillix Data Sheet is Not Prior Art

The Data Sheet was printed after the February 3, 2000 filing date for the subject application, and thus could not have been published before that date. Thus, the Data Sheet is not prior art to the subject application, and the rejection is respectfully traversed for this reason. Withdrawal of the rejection is requested.

2.2. Quillix Press Release Does Not Disclose At Least Some Aspects of Claimed Invention

The Office action alleges that Exhibit 21 pertaining to January 18, 2000 Quillix Press Releases on pages 60-62 of Applicant's Response filed May 7, 2004, was an admission that the Quillix software was prior art. What was stated in the Response is as follows:

Thus, according to Prevalent Software, Inc., "Quillix is the first true enterprise, distributed capture system built for the Internet." Further, IDT's President

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characterizes the Quillix solution as "a revolutionary document and data capture product for the eCommerce industry." This is further evidence of the long-felt need in the art for the claimed invention – to be the "first true enterprise, distributed capture system built for the Internet," and "revolutionary," there must have been a long-felt need for the claimed invention (not to mention attempts by others that had failed to attain the claimed invention). Because Quillix appears to contain similar or the same functionality as the claimed invention, it is submitted that there was a long-felt need in the art for the claimed invention that was not satisfied until the claimed invention was made. [Emphasis added]

The language "appears to contain similar or the same functionality" allows that the Quillix software may not be the same as the claimed invention given the documents of Exhibit 21 do not completely describe the Quillix software. This statement certainly was not meant to controvert what the Quillix Press Release and Data Sheet and documents actually state, and numerous if not all of the pending Claims are in no way disclosed or even suggested in the Quillix citations. In addition, subsequent to the May 7, 2004 Response, numerous of the Claims have been amended. For example, Claim 1 has been amended to state "a document display portion, an index field portion, and control portion all visibly defined in the display in separate portions thereof by the HTML document..."; and Claims 41, 50 have been amended to state "the display generated by the HTML document including a document display portion, and index field portion, and a control portion separately defined in the display." Neither the Quillix Data Sheet nor Press Release disclose these features. Thus, Claims 1, 41, and 50 and their corresponding dependent Claims are patentable for at least these reasons.

2.3. Applicant "Swears Back" of Citations Pertaining to Quillix Software

Attached is the Declaration of one of the inventors Alexandre Okonechnikov with attached Exhibits A-C providing evidence to corroborate the conception and reduction to practice of the invention before January 18, 2000, the date of the press release for the Quillix software. As can be seen in the attached Declaration, the subject matter of at least Claims 1, 3-16, 18-22,

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24-27, 29-33, 35-53, 55-62, and 64-75 were conceived and reduced to practice by the inventors before January 18, 2000. Withdrawal of the rejection as to all pending Claims is requested.

3. Rejection of Claims 2, 23, 63 under 35 U.S.C. §103(a) based on Quillix Citations

On pages 20-23 of the Office action, Claims 2, 23, and 63 were rejected under 35 U.S.C. 103(a) as being unpatentable over "Quillix."

3.1. Quillix Data Sheet is Not Prior Art

As explained above, the Quillix Data Sheet is not prior art to the subject application. Accordingly, a prima facie case of obviousness has not been established for this reason.

3.2. Claims 2, 23, and 63 Patentably Distinguish Over the Prior Art

In any case, Claims 2 and 63 depend from Claim 1, and Claim 23 depends from Claim 9, and thus include all limitations of their respective independent Claims. Thus, Claims 2, 23 and 63 distinguish over the prior art for reasons previously stated with respect to Claims 1 and 9.

In addition, Claim 2 recites "wherein the control element is operable by the user with the input device to alternately generate the start scan signal and the send data signal with respective successive activations of the control element." Claim 23 states "wherein the start scan signal and the send data signal are input by the user with the input device via a common control element displayed within the web browser of the user interface that toggles between a first scan mode for the performance of said step (a) and a second send mode for the performance of said step (m)." Claim 63 recites "index data input in said step (b) comprises a file path indicating the subdirectory on the server at which the scanned document is to be stored." The Quillix citations do not disclose or even suggest these limitations. Accordingly, these Claims are patentable over the prior art.

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3.3. Applicant "Swears Back" of Citations Pertaining to Quillix Software

Applicant submits the attached Declaration to "swear back" of the January 18, 2000 Quillix Press Release. Therefore, the Quillix citations are not prior art to the subject application, and they cannot be relied upon to reject the Claims under 35 U.S.C. 103(a).

3.4. Claim 63 as Amended is Not Directed to Non-Functional Descriptive Material

Claim 63 recites that the "index data input in said step (b) comprises a file path indicating the subdirectory on the server at which the [[scanned]] document data is to be stored." The Office action alleges that the file path is merely descriptive material. The Federal Circuit cautions against liberal use of the so-called "printed matter" rejection. *In re Gulack*, 703 F.2d at 1385, n.8 (Fed. Cir. 1983). The limitation of Claim 63 is related functionally to the inputting step, and is thus intrinsically bound to the function of inputting the index data which is done differently depending upon what the data to be input is. Further, Claim 1, from which Claim 63 depends, recites that the index data is input in association with the document data into the display generated in step (a). For reasons similar to the holding in *In re Lowry*, 32 F.3d 1579 (Fed.Cir. 1994), which involved structures storing related data, the relationship between the index data and document data is directed to patentable subject matter. Withdrawal of the rejection is requested for this additional reason.

3.5. Traversal of Approach to Obviousness Analysis

The Office action attempts to take Official Notice of the fact that a toggle button was known in the art at the time of the invention. However, under 35 U.S.C. 103(a), the subject matter of the Claims must be considered "as a whole." Thus, the element the Examiner must produce prior art that discloses a toggle button that has the function of scanning a document and transmitting document data by successive activations. That kind of toggle button was not known to anyone else in the art, and the attempt to take Official Notice of the existence of toggle button used for other functions skews the appropriate focus for the obviousness analysis. In other words, the piecemeal approach taken in the Office action by attempting to dissect the claim language rather than consider it as a whole is respectfully traversed, and for this reason so too is

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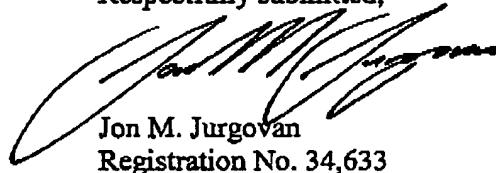
the taking of Official Notice and, more generally, the rejection under 35 U.S.C. 103(a). See, e.g., *In re Gulack*, 703 F.2d 1381 (Fed. Cir. 1983). Withdrawal of the rejection is requested.

4. Conclusion

It is submitted that all of pending Claims 1-16, 18-27, 29-33, 35-53 and 55-75 are patentable over the prior art of record for at least the above-stated reasons. Reconsideration of Claims 1-16, 18-27, 29-33, 35-53, and 55-75 and an early Notice of Allowance for all pending claims, are respectfully requested.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,



Jon M. Jurgovan
Registration No. 34,633

Customer No. 00826
ALSTON & BIRD LLP
Bank of America Plaza
101 South Tryon Street, Suite 4000
Charlotte, NC 28280-4000
Tel Atlanta Office (404) 881-7000
Fax Atlanta Office (404) 881-7777